

REMARKS/ARGUMENTS

Claims 1-64 are pending in the application. The claims were rejected in the Office Action dated October 8, 2008. Applicant, by this paper, amends claims 1, 27, 42, and 62-64. All amended claims are supported by the Specification, as filed. No new matter has been added. Applicant respectfully requests reconsideration and allowance of all pending claims.

Discussion of Objections to the Oath/Declaration

Applicant submits, herewith, a Supplemental Declaration executed by the inventor to overcome any deficiencies in the previously filed oath or declaration. The objection to the oath is believed to be overcome with the submission of the Supplemental Declaration, and Applicant requests reconsideration and withdrawal of the objection.

Discussion of Objections to the Specification

The Abstract is objected to as not commencing on a separate sheet. Applicant submits herewith a revised copy of the Abstract appearing on a separate sheet. Applicant requests reconsideration and withdrawal of the objection to the Specification in light of the submission of the Abstract with this paper.

Discussion of Rejections Under 35 U.S.C. §102

Claims 1-3, 5-6, 9-10, 14, 16-17, 19-27, 31-32, 35-36, 39, 41-43, 45, 48-49, 52, and 54-64 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2003/0008669 to Stein et al. (hereinafter Stein).

In order for a claim to be anticipated, a single prior art reference must describe, either expressly or inherently, each and every element as set forth in the claim. Applicant contends that the claims, either as originally presented or amended, include at least one claimed feature not described in Stein.

**Claim 1** recites a method of calculating an estimate of the position of a mobile station. The method includes "collecting in a mobile station, position estimate information (PEI) transmitted by a location node in one or more messages carried on at least one of a common channel or a dedicated channel, and wherein the PEI in the one or more messages includes a location node identification and longitude and latitude information of the location node." These features are described, for example, in Applicant's original Specification at paragraph [0025].

The paragraph describes the messages containing the PEI may be sent on common channels as well as on dedicated channels. Additionally, the PEI includes latitude and longitude information of the location node. This feature is described at Table 1 of the Specification, as filed.

Stein fails to describe at least this claimed feature. Stein describes a repeater transmitting a PN sequence at a particular time offsets reserved for repeater identification. *See, Stein, Abstract* (“The identification codes for the repeaters in the system can be implemented with PN sequences at defined offsets that are specifically reserved for repeater identification.”)

Stein fails to describe any messages that contain the PEI. Instead, Stein describes a PN sequence offset timing as identifying a repeater. The PN sequence offset timing does not include a location node identification that is contained in a message that is carried on a common channel or a dedicated channel. Stein fails to describe any message transmitted by a location node that includes the location node identification.

Stein fails to describe how any PEI information, such as longitude and latitude, can be included in a message, because Stein fails to describe the PEI as transmitted on messages. Instead, Stein describes identifying the repeater based on the PN sequence or the PN offset, and thus Stein fails to describe a message that has the capability of carrying a full complement of PEI.

Thus, Stein fails to describe every claimed feature from claim 1 and does not anticipate claim 1. Applicant respectfully requests reconsideration and allowance of claim 1.

**Claims 42 and 62** include features that are substantially the same as those discussed above in relation to claim 1. Claims 42 and 62 are believed to be allowable at least for the same reasons as presented above in relation to claim 1. Applicant respectfully requests reconsideration and allowance of claims 42 and 62.

**Claim 27** includes the feature of “receiving in a position determination entity, the PEI parameters which have been sent by the mobile station, the PEI parameters including information from which the location node can be located or identified and wherein the PEI parameters contain some or all of the PEI received from the location node and additional information which can be identified by the mobile station based on longitude and latitude information included in the PEI.”

Stein fails to describe a mobile station generating PEI parameters that includes information that is based on latitude and longitude information included in the PEI, or communicating this information to a PDE. Thus, Stein fails to anticipate claim 27.

**Claim 63** includes a feature that is substantially the same as the one discussed above in relation to claim 27. Claim 63 is believed to be allowable at least for the reasons presented above in relation to claim 27. Applicant respectfully requests reconsideration and allowance of claims 27 and 63.

**Claim 64** recites a system for calculating a position estimate of a mobile station. Claim 64 includes substantially the features discussed above in relation to claim 1 and claim 27. Claim 64 is believed to be allowable at least for the reasons presented above in one or both of claims 1 and 27. Applicant respectfully requests reconsideration and allowance of claim 64.

Discussion of Rejections Under 35 U.S.C. §103

Claims 4, 7-8, 11-13, 15, 18, 28-30, 33-34, 37-38, 40, 46-47, 50-51 and 53 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the combination of Stein with one or more of U.S. Patent Application Publication No. 2003/0050077 to Takeuchi et al. (hereinafter Takeuchi), U.S. Patent No. 6,330,454 to Verdonk (hereinafter Verdonk), U.S. Patent No. 6,166,685 to Soliman (hereinafter Soliman), or U.S. Patent No. 5,734,977 to Sanmugam, U.S. Patent No. 6,198,935 to Saha et al. (hereinafter Saha).

Each of the rejections under 35 U.S.C. §103(a) relies on Stein. Applicant respectfully requests reconsideration and allowance of claims 4, 7-8, 11-13, 15, 18, 28-30, 33-34, 37-38, 40, 46-47, 50-51 and 53, because Stein fails to qualify as a prior art reference for the purposes of a 35 U.S.C. §103(a) rejection.

Stein is disqualified as prior art against the claimed invention as provided in 35 U.S.C. §103(c)(1). Stein is not available as a prior art reference under 35 U.S.C. §103(a), because Stein (2003/0008669) and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Stein (U.S. Application No. 10/132,908) issued on November 21, 2006 and is assigned to Qualcomm Incorporated, the assignee of the instant application, as demonstrated by assignment information listed on the face of the patent.

The assignment of the invention of the instant application to Qualcomm Incorporated is recorded with the PTO on November 1, 2007, at Reel 0200500 and Frame 0675.

**STATEMENT OF COMMON OWNERSHIP**

U.S. Patent Application No. 10/580,622 (the instant application) and U.S. Patent Application No. 10/132,908 to Stein were, at the time the invention of the instant application was made, owned by Qualcomm Incorporated, or subject to an obligation of assignment to Qualcomm Incorporated.

Stein is disqualified as prior art under 35 U.S.C. §103(c) because Stein only qualifies as prior art under 35 U.S.C. 102(e). Stein and the instant application were, at the time the invention of the instant application was made, owned by Qualcomm Incorporated, or subject to an obligation of assignment to Qualcomm Incorporated.

None of the rejections made under 35 U.S.C. §103(a) may be maintained in light of the disqualification of Stein as a prior art reference. Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a).

**Discussion of Dependent Claims**

Claims 2-3, 5-6, 9-10, 14, 16-17, 19-26, 31-32, 35-36, 39, 41, 43, 45, 48-49, 52, and 54-61 depend, either directly or indirectly, from one of independent claims 1, 27, or 42. The dependent claims are believed to be allowable based at least in part on their dependence from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2-3, 5-6, 9-10, 14, 16-17, 19-26, 31-32, 35-36, 39, 41, 43, 45, 48-49, 52, and 54-61.

**CONCLUSION**

Applicant believes that all claims pending in the application are allowable.

Applicant petitions the Director of the United States Patent Office to extend the time for reply to the Office Action dated October 8, 2008 for one month and authorizes the charge as set forth in §1.17(a) to Deposit Account No. 17-0026. Applicant believes that the instant response is filed within the period for response provided in the Office Action of October 8, 2008 extended by one month as provided for under 37 CFR 1.136.

Docket No. 040132

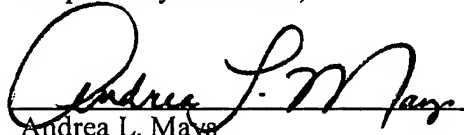
Serial No. 10/580,622

If there are any other fees due in connection with the filing of the response, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Applicant therefore respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned.

Dated: 3/5/09

Respectfully submitted,

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